



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY Docket No.
08/067,148	05/26/93	MONTAGNIER	L 3495.000404

18N1/1115
FINNEGAN, HENDERSON, FARABOW,
GARRETT AND DUNNER
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER	
ART UNIT	PAPER NUMBER
1813	
DATE MAILED: 11/15/94	

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- ☐ is extended to run _____ from the date of the Final Rejection
- ☒ continues to run 3 months from the date of the Final Rejection
- ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

- ☒ Applicant's response to the final rejection, filed 10/14/94, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - ☐ They raise the issue of new matter. (See Note).
 - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing of an appeal, the proposed amendment ☒ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

Allowed claims: _____

Claims objected to: _____

Claims rejected: 15, 16, 18-20, & 29-31

However:

- a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
- b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Serial Number: 08/067148
Art Unit: 1813

-2-

This Advisory Action is in response to the Response to Final Rejection filed 10/11/94. Claims 17, 21-28, and 32-36 have been cancelled. Claims 15, 16, 18-20, and 29-31 are pending and under final rejection.

The Examiner hereby acknowledges the submission of the new title.

The rejection of claims 1-5, 7, and 8 under 35 U.S.C. § 102(a) as being anticipated by Barre-Sinoussi et al is withdrawn in view of the cancellation of these claims.

Claims 29-31 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility.

Applicant's arguments have been fully considered but are not deemed to be persuasive.

Applicant argues that immune complexes have utility as chemical intermediates for purifying members of the immune complexes. This is not deemed to be persuasive because the disclosed utility is directed to detecting the presence of anti-HIV antibodies, not purifying immune complex components. The claimed complexes have no utility of themselves in the instant specification. The only context of the complexes in the instant invention is as a final product in the method of detecting the presence of antibodies or antigens.

The specification is objected to and claims 15, 16, 18-20, and 29-31 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

Applicant's arguments have been fully considered but are not deemed to be persuasive.

In response to the enablement issue, Applicant has submitted a new catalog of citations from the specification purporting to show support for the claimed invention. A review of the relevant passages is not convincing. The referenced area of page 3 was cancelled by paper #7. Page 4, lines 1-5 has introductory remarks that are general and prophetic in nature regarding the use of proteins as reagents to detect infection. Pages 10 and 11 show that immune complexes are the result of the interaction of radiolabelled proteins with antibodies found in sera from infected individuals. The complexes are not used as an intermediate in the purification of the antibodies of the proteins. Page 13 teaches that antibodies to several proteins are found in sera from infected individuals but is silent in regards to isolating proteins, antibodies, or complexes. Pages 22-23 teach detecting gp110 on a viral lysate with reactive sera. There is no teaching of isolating immune complexes. Figure 5 is unreadable. None of these citations teaches isolating "complexes". Complexes are formed in the course of reacting the unknown antibody with a known antigen to detect the presence of the antibody. Conversely, the complexes are formed by

reacting unknown antigens with antibodies to detect the antigens. Nowhere does the specification teach the isolation and purification of complexes or the purification of antigens or antibodies from complexes.

The specification makes only a passing and merely prophetic reference to the development of monoclonal antibodies. The specification is not enabled for the use of monoclonal antibodies.

Claims 15-21 and 32-36 are rejected under 35 U.S.C. § 103 as being unpatentable over Barre-Sinoussi et al.

This rejection remains in effect for the same reasons as set forth in the 35 U.S.C. § 102(a) rejection, *supra*.

Applicant's arguments have been fully considered but are not deemed to be persuasive.

Applicant again argues that the Great Britain and South African patent applications antedate the reference and therefore render it improper as prior art. Applicant points to GB 83 24800, page 7, line 30 to page 7 [sic, 8?], line 31 and SA 84 7005, page 7, line 30 to page 8, line 32, as that the priority documents enable the isolation of particular proteins. This is irrelevant as the proteins are not claimed. Further, the proteins listed in the priority documents are not as extensive as those listed by Applicant in the arguments. Applicant also points to page 21, lines 32-39, of each document to show immune complexes. The referenced sections merely note that p25 can be a reagent that can

Serial Number: 08/067148
Art Unit: 1813

-5-

be used for the production of antibodies. There are no teachings as to how one would do produce the antibodies.

No claims are allowed.

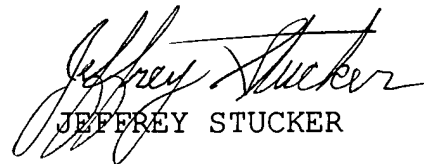
Papers related this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 180 Fax number is: (703) 305-3014.

The Fax center number for assistance is: (703) 308-4744.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jeffrey Stucker whose telephone number is (703) 308-4237.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JEFFREY STUCKER



CHRISTINE M. NICKER
SUPERVISORY PATENT EXAMINER
GROUP 180